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AARON L. SCHWARTZ\*\*

\*LIMITED TO MATTERS  
AND PROCEEDINGS BEFORE  
FEDERAL COURTS & AGENCIES  
\*\*REGISTERED PATENT AGENT  
\*\*\*SENIOR COUNSEL

November 21, 2001

**WRITER'S DIRECT NUMBER:**

(202) 371-2560

**INTERNET ADDRESS:**

RESMOND@SKGF.COM

Commissioner for Patents  
Washington, D.C. 20231

**Box: CPA**

Re: U.S. Utility Patent Application  
Request for Continued Prosecution Application (CPA)  
Appl. No. 09/390,634; Filed: September 7, 1999  
For: **Method for Expanding Embryonic Stem Cells in Serum-Free Culture**  
Inventors: Price *et al.*  
Our Ref: 0942.4190002/RWE/FRC

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Fee Transmittal Form PTO/SB/17;
2. Petition For Extension of Time Under 37 C.F.R. § 1.136(a)(1) (*in duplicate*);
3. CPA Transmittal Form PTO/SB/29 (*in duplicate*);
4. Supplemental Reply;
5. First Supplemental Information Disclosure Statement;
6. Listing of the cited documents on Form PTO-1449 (2 sheets);
7. A copy of each of the three (3) cited documents on Form PTO-1449;

11/23/2001 10:03:10  
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04 FC:104  
05 FC:105  
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Commissioner for Patents

November 21, 2001

Page 2

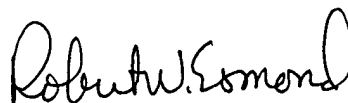
8. Check No. **33295** in the amount of **\$4,158.00** to cover:
- |            |  |
|------------|--|
| \$740.00   | Basic filing fee (37 C.F.R. § 1.16(a));              |
| \$522.00   | Fee for extra dependent claims;                      |
| \$1,176.00 | Fee for extra independent claims;                    |
| \$280.00   | Multiple dependent claims                            |
| \$1,440.00 | Extension of Time Under 37 C.F.R. § 1.136(a)(1); and |
9. One return postcard.

It is respectfully requested that the attached postcard be stamped with the filing date of these documents and returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

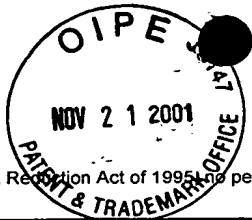
Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond  
Attorney for Applicants  
Registration No. 32,893

RWE/FRC/pcd  
Encls.



RECEIVED #15  
NOV 30 2001  
12-28-01

TECH CENTER  
PTO/SB/29 (10-00)  
Approved for use through 10/8/2002 OMB 0651-0032  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

### CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.  
(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

CHECK BOX if applicable:  
☒ **DUPLICATE**

Address to:  Assistant Commissioner for Patents Box CPA Washington, DC 20231	Attorney Docket No. of Prior Application	0942.4190002/RWE/FRC
	First Named Inventor	Paul J. Price
	Examiner Name	Kerr, J.
	Group/Art Unit	1633
	Express Mail Label No.	

This is a request for a ☒ continuation or ☐ divisional application under 37 CFR § 1.53(d),  
(continued prosecution application (CPA)) of the prior application number 09/390,634,  
filed on September 7, 1999 entitled: Method for Expanding Embryonic Stem Cells in Serum-Free Culture.

#### NOTES

**FILING QUALIFICATIONS:** The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR § 1.51(b) or (2) the national stage of an international application in compliance with 35 U.S.C. 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice Changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000). 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).

**C-I-P NOT PERMITTED:** A continuation-in-part application cannot be filed as a CPA under 37 CFR § 1.53(d), but must be filed under 37 CFR § 1.53(b).

**EXPRESS ABANDONMENT OF PRIOR APPLICATION:** The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR § 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

**ACCESS TO PRIOR APPLICATION:** The filing of this CPA will be construed to include a waiver of confidentiality by the application under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR § 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

**35 U.S.C. 120 STATEMENT:** In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR § 1.78(a).

**Warning: Information on this form may become public. Credit Card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

1. ☐ Enter the unentered amendment previously filed on \_\_\_\_\_ under 37 CFR § 1.116 in the prior nonprovisional application.
2. ☐ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 CFR § 1.53(d)(4).
  - a. ☐ **DELETE** the following inventor(s) named in the prior nonprovisional application:  
.....
  - b. ☐ The inventor(s) to be deleted are set forth in a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
  - a. ☒ PTO-1449
  - b. ☒ Copies of IDS citations

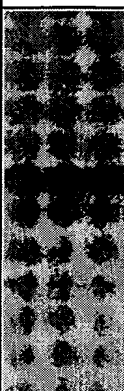


[Page 1 of 2]

Burden Hour Statement: this form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

11/23/2001 MGE BREM1 00000020 09390634

01 FC:131	740.00 OP
02 FC:102	1176.00 OP
03 FC:103	522.00 OP
04 FC:104	280.00 OP

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 CFR § 1.16(c) or (j))	49-20* =	29	x \$ 18.00 =	\$522.00
	INDEPENDENT CLAIMS (37 CFR § 1.16(b) or (i))	17-3** =	14	x \$ 84.00 =	1,176.00
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR § 1.16(d))			x \$ 280.00 =	280.00
				BASIC FEE (37 CFR § 1.16)	\$ 740.00
				Total of above Calculations	2,718.00
	Reduction by 50% for filing by small entity (Note 37 CFR 1.27).				
* Reissue claims in excess of 20 and over original patent. **Reissue independent claims over original patent.			TOTAL =		

6. ☐ Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 19-0036:
- a. ☒ Fees required under 37 CFR § 1.16. b. ☐ Fees required under 37 CFR § 1.17.
- c. ☐ Fees required under 37 CFR § 1.18.
8. ☒ A check in the amount of \$ 4,158.00 is enclosed.
9. ☐ Payment by credit card. Form PTO-2038 is enclosed.
10. ☐ Applicant requests suspension of action under 37 CFR 1.103(b) for a period of \_\_\_\_\_ months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.
11. ☐ New Attorney Docket Number, if desired \_\_\_\_\_  
[Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.]
12. a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A)  
b. ☒ Return Receipt Postcard (Should be specifically itemized, See MPEP 503)
13. ☒ Other: A Petition for the Extension of Time for the Parent Application  
☒ Other: The Name of the Assignee is: Invitrogen Corporation  
☒ Other: Supplemental Reply

NOTE: The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.

## 14. NEW CORRESPONDENCE ADDRESS

☒ Customer Number or Bar Code Label

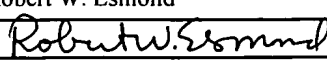
(Insert Customer No. or Attach bar code label here)

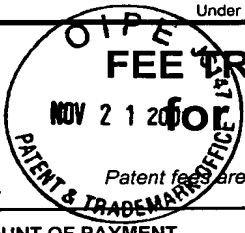
or ☐ New correspondence address below

Customer No. 26111

Name	Sterne, Kessler, Goldstein & Fox P.L.L.C.			
Address				
City	State	Zip Code		
Country	Telephone	Fax		

## 15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Robert W. Esmond
Signature	
Registration No. (Attorney/Agent)	32,893
Date	Nov. 21, 2001



# FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$)**4,158.00**

## Complete if Known

Application Number 09/390,634  
Filing Date September 7, 1999  
First Named Inventor Paul J. Price  
Examiner Name Kerr, J.  
Group Art Unit 1633  
Attorney Docket No. 0942.4190002/BWE/FRC

RECEIVED  
NOV 21 2001  
PATENT & TRADEMARK OFFICE

### METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number 19-0036  
Deposit Account Name Sterne, Kessler, Goldstein & Fox P.L.L.C.

☐ Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17

☐ Applicant claims small entity status See 37 CFR 1.27

2. ☒ Payment Enclosed:

☒ Check ☐ Credit card ☐ Money Order ☒ Other\*

\*Charge any deficiencies or credit any overpayments in the fees or fee calculations of Parts 1, 2 and 3 below to Deposit Account No. 19-0036.

### FEE CALCULATION

#### 1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	740.00
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) (\$) 740.00

#### 2. EXTRA CLAIM FEES

	Extra	Fee from below	Fee Paid
Total Claims 49 - 20** = 29	X 18	=	522.00
Indep. Claims 17 - 3** = 14	X 14	=	1,176.00
Multiple Dependent	280	=	280.00

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim
108	84	209	42	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 1,978.00

\*\*or number previously paid, if greater; For Reissues, see above

### FEE CALCULATION (continued)

#### 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	1,440.00
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	130	123	130	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	481	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) :

Other fee (specify) :

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 1,440.00

### SUBMITTED BY

Name (Print/Type) Robert W. Esmond  
Signature *Robert W. Esmond*

Registration No. (Attorney/Agent) 32,893  
Telephone 202-371-2600

Date Nov. 21, 2001

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

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